Supreme Court, U.S.
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No. 07- (1)

IN THE
Supreme Court of the United States

STRYKER CORPORATION,

Petitioner,

v.

TRIMED, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the Federal Circuit has eroded the public notice function served through a patent's prosecution history by disregarding a patent applicant's concessions concerning a patent claim feature in a bargained-for-agreement with the United States Patent and Trademark Office where a) the Patent Office Examiner stated in the written record that "[a]greement was reached that the expression of this feature in a means plus function format and better defining the holes of the plate would distinguish over the prior art of record" to allow the patent, b) the patent applicant then rewrote the claim language in the agreed-to "means plus function format" and secured issuance of the patent, but c) the Federal Circuit held that the claim language was not a "means plus function" element under 35 U.S.C. § 112, ¶ 6, thereby allowing the patent owner to escape summary judgment of non-infringement and depriving the public of the ability to rely on the patent's prosecution history in evaluating the metes and bounds of patent claims.

2. Whether the Federal Circuit erred in its statutory construction of 35 U.S.C. § 112, ¶ 6, as it has erred over a long period of time, by invoking a judicially-created exception to the statutory mandate of 35 U.S.C. § 112, ¶ 6, where the Federal Circuit avoids construing a claim element written in "means for performing a specified function" language under the statute which, in contrast and without any listed exceptions, states that a claim element "expressed as a means . . . for performing a specified function without the recital of structure, material or acts . . . **shall be construed** to cover the corresponding structure, material or acts described in the specification and equivalents thereof."

RULE 14.1(b) AND 29.6 STATEMENT

Pursuant to Supreme Court Rule 14.1(b), Petitioner Stryker Corporation ("Petitioner") states that all parties to the proceedings below appear in the caption of the case on the cover page.

Pursuant to Supreme Court Rule 29.6, Petitioner states that no publicly traded company owns 10 percent or more of Stryker Corporation.

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Stryker Corporation ("Petitioner") hereby petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion and order of the United States District Court for the Central District of California ("District Court") granting summary judgment in favor of Petitioner is unreported and is set forth in the Appendix ("App.") at 18a-39a. The opinion and order of the United States Court of Appeals for the Federal Circuit reversing the judgment of the District Court is reported at 514 F.3d 1256 and is also set forth at App. 1a-13a. The Federal Circuit's order denying rehearing *en banc* is unreported and is reproduced at App. 43a-44a.

JURISDICTION

The District Court had jurisdiction to hear TriMed, Incorporated's ("Respondent") complaint pursuant to 28 U.S.C. §§ 1331 and 1338. The Federal Circuit had jurisdiction to hear Respondent's appeal pursuant to 28 U.S.C. § 1295(a)(1). The Federal Circuit rendered its decision on January 29, 2008. Petitioner filed a timely petition for rehearing *en banc* by the Federal Circuit, which was denied on March 10, 2008. This Court's jurisdiction, under 28 U.S.C. § 1254(1), is thus timely invoked.

STATUTORY PROVISIONS INVOLVED

This case concerns the proper interpretation of a patent claim element written as a means for performing a specified function, otherwise known as means-plus-function format. Section 112, paragraph 6 of Title 35 of the United States Code governs the proper interpretation of elements written in means-plus-function format in a patent claim. It provides:

> An element in a claim for a combination may be expressed as a means or a step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

STATEMENT OF THE CASE

This case raises important questions regarding two critical aspects of claim construction in patent law. First, this case raises a vital question regarding the public notice function served by a patent's prosecution history. May a court simply dismiss a patent's prosecution history when an applicant, to obtain the patent, makes an agreement with the United States Patent and Trademark Office ("Patent Office") regarding the scope and interpretation of a claim element? Second, this case raises fundamental questions regarding proper statutory interpretation of a federal statute. In particular, should a court be allowed to create a judicial exception to the express mandate of 35 U.S.C. § 112,

¶ 6, and as a result allow a patent owner to broaden impermissibly its claims during a later-initiated infringement action?

Perceiving fundamental problems with allowing an applicant to claim his or her invention using functional language, in 1946 this Court prohibited the use of means-plus-function language in patent claims. *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 9-12 (1946). In 1952, however, Congress addressed this issue with the enactment of 35 U.S.C. § 112, ¶ 6. While Congress determined that applicants could express their inventions in means-plus-function format, Congress concurrently attempted to rectify the indefiniteness problems that previously plagued such claim language. In particular, to prevent applicants from claiming their inventions in an impermissibly broad or ambiguous manner, Congress limited the scope of means-plus-function claim elements to those structures (or equivalents) that were recited in the specification for performing the claimed functions. *See* 35 U.S.C. § 112, ¶ 6.

By applying its own judicially-created exception to this federal statute, the Federal Circuit has eroded the safeguards put in place by Congress. Because the Federal Circuit does not apply the claim construction mandate of 35 U.S.C. § 112, ¶ 6 to all claim elements which invoke "means" language, the statutory safeguards are not universally applied to all such claim elements. Specifically, rather than universally apply the mandate of § 112, ¶ 6, the Federal Circuit only applies the statutory framework presumptively. *See, e.g., Biomedino, LLC v. Water Techs. Corp.*, 490 F.3d 946,

950 (Fed. Cir. 2007). If the Federal Circuit believes that the claim language recites "sufficient structure," then the Federal Circuit interprets the claim language without reference to the claim construction mandate set forth in § 112, ¶ 6. *Id.* Consequently, just like the pre-*Halliburton* era, applicants again are allowed to claim their inventions with language that is often times overly broad, indefinite and ambiguous.

This case epitomizes the Federal Circuit's problematic approach to means-plus-function claim elements. Here, Robert Medoff ("the Applicant") used the statutory "means for performing a specified function" language to express a critical claim element. Moreover, in exchange for receiving a patent monopoly from the government, the Applicant agreed with the Patent Office during an interview with the Patent Office Examiner that the critical aspect of his alleged invention would be expressed in means-plus-function format. Supplement Appendix ("Supp. App.") at SA-7. In other words, the Applicant agreed that his monopoly would be limited to the structures described in the specification, and equivalents thereof, that performed the claimed functions. The Applicant then proceeded to amend his patent claim to place expressly the "means for performing a specified function" language in the claims of the issued patent. Supp. App. at SA-8-SA-13. Nevertheless, accepting an argument raised by the patent owner (Respondent) to escape summary judgment of non-infringement against it, the Federal Circuit refused to invoke the statutory mandate of 35 U.S.C. § 112, ¶ 6. App. at 6a-10a. Without the statutory safeguards in place, the Federal Circuit allowed Respondent to expand its monopoly to include

structures not recited in the specification, or equivalents thereof, for performing the claimed functions.

The Federal Circuit's refusal to apply consistently 35 U.S.C. § 112, ¶ 6 results in problematic uncertainty regarding the scope of a patent's claims. In many cases, neither the government, the applicant, nor the public will know if a claim element will be interpreted narrowly as a means-plus-function element or broadly not as a means-plus-function element until the claim language is subjected to litigation. That litigation may not occur until years after the patent issues.

This Court, however, recognizes that "[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject matter will be dedicated ultimately to the public." *Gen. Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938). This case provides an excellent vehicle for the Court to reinforce the paramount importance of enabling the government, the applicant and most importantly the public to ascertain predictably the boundaries of a patent owner's monopoly. By addressing the proper statutory construction of 35 U.S.C. § 112, ¶ 6, this Court will provide the Patent Office, the applicants, the public, and the lower courts with much needed clarity regarding the scope of claim elements written with "means for performing a specified function" language.

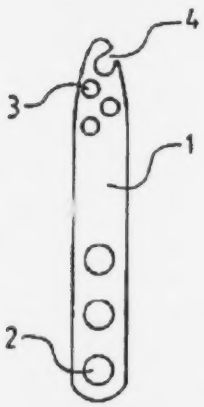
This case is a proper vehicle for this Court to address the role of the prosecution history in claim construction. A patent, like any other written instrument, should be interpreted in accordance with the intrinsic evidence.

In the context of patents, the intrinsic evidence includes the claims, the specification, and the prosecution history. In fact, alongside the claims and the specification, the prosecution history is a vital tool in claim construction. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733 (2002) ("Prosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. Estoppel is a 'rule of patent construction' that ensures that claims are interpreted by reference to those 'that have been cancelled or rejected.'"); *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed. Cir. 1996).

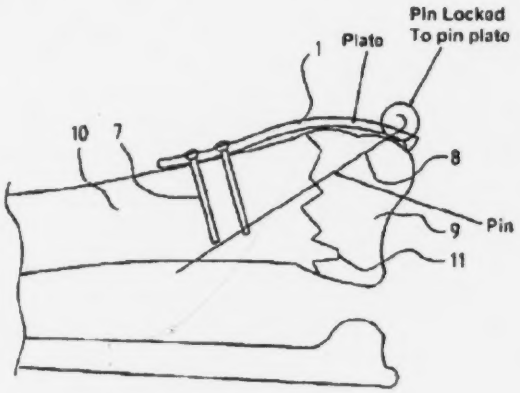
The public is entitled to rely on an applicant's express statements during patent prosecution when ascertaining the scope of protection afforded by the patent that ultimately issues. As a corollary, an applicant ought to be bound by any representations it made to or agreements it made with the Patent Office to obtain allowance of the patent. As such, in this case for example, Respondent should not be allowed to breach the agreement struck with the Patent Office in order to avoid a finding of non-infringement. The straightforward nature of the prosecution history in this case makes it a proper vehicle for this Court to address the significance of a patent's prosecution history in construing a patent.

The Technology at Issue

The technology at issue in this case is simple and straightforward. In general, United States Patent No. 5,931,839 ("the '839 patent") relates to the fixation of broken bones, in particular the fixation of fractures of the distal radius (the wrist). The technology described in the '839 patent discloses plates with special holes, screws and pins for fixing broken bones. Pictures of the plate/screw/pin assembly of the '839 patent are shown in the drawings below, which are taken from the figures of the '839 patent:



From Fig. 1
of the '839 Patent



From Fig. 5
of the '839 Patent

As shown in the above drawings, the bone fracture is shown at 11. The plate 1 is placed over the stable bone 10 and the fractured bone 9. At one end, the plate 1 has holes 2 for the insertion of screws 7. The screws 7 secure the plate to the stable bone 10. At the other end of the plate, there are holes 3 and/or special holes with slots 4 for the insertion of pins 8. The pins 8 slide axially

through the holes 3 or the hole/slot combination 4 into the fractured bone 9, across the fracture 11, and into the stable bone 10.

As described in the patent, but *not* shown in the drawings (other than the hole with a slot), a special hole has an additional structure to lock the pin to the plate so that the near end of the pin is stabilized against displacement in the plane of the plate. These additional necessary structures include: (1) a hole with a **slot**; (2) a **threaded hole** with threaded pins; (3) a hole with **locking means**; (4) an **undersized hole with a cut** extending from the hole to the edge of the plate; (5) a **slotted hole** joined by a slightly undersized hole; and (6) a hole used with one or more **threaded or slotted studs**. Supp. App. at SA-6.

Claim 1 is the only independent claim of the '839 patent. Currently at issue in this case is the construction of the last element of that claim reproduced in bold below. In full, claim 1 of the '839 patent reads:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions,
>
> fastening means for securing one end portion of said plate to stable bone,
>
> at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable

> bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin,
>
> the opposite, near end of said pin being adapted for extending from the fractured bone fragment,
>
> said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate,
>
> said holes in said plate providing **means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate**.

Supp. App. at SA-6 (emphasis added).

The Prosecution History

The Applicant, Robert Medoff, had a difficult time obtaining allowance of the '839 patent. When the Patent Office issued a final rejection of the pending claims of the '839 patent, the Applicant requested an interview with the Patent Office Examiner to discuss the final rejection of the claims. On August 17, 1998, the Patent Office Examiner conducted an interview with the Applicant and his lawyer. As memorialized in the Interview Summary written by the Patent Office Examiner, the Patent Office Examiner and the Applicant agreed that the Applicant could obtain allowance of the

claims if the Applicant wrote the last element of claim 1 in means-plus-function format and better defined the holes of the plate:

> The examiner explained the rejection to the applicant. Discussion centered around focusing on the structural difference between the applicant's pin/plate attachment and the conventional screw/plate attachment of the prior art (as shown for example by Lin). The configuration of the present device allows the pin to be attached to the plate in a sliding manner that prevents compression across the fracture. **Agreement was reached that the expression of this feature in a means plus function format and better defining the holes of the plate would distinguish over the prior art of record.**

Supp. App. at SA-7 (emphasis added).

Subsequently, the Applicant did in fact amend claim 1 of the '839 patent to include "means for performing a specified function" language. Supp. App. at SA-9. Moreover, the Applicant expressly told the Patent Office Examiner that the amendment was made "[i]n accordance with the determinations made at [sic] interview"—*i.e.*, the determination that the last element of claim 1 was to be written in means-plus-function format. Supp. App. at SA-11. The Patent Office allowed the claims of the '839 patent in light of the Applicant's amendment. No fair reading of this public record could reach any conclusion other than the one reached by the District Court—the last claim element of claim 1 is a "means plus function" claim element subject to 35 U.S.C. § 112, ¶ 6.

The District Court's Rulings

Respondent TriMed, Incorporated ("Respondent") filed the present lawsuit asserting that Petitioner's distal radius fracture fixation system allegedly infringes claims of the '839 patent in the United States District Court for the Central District of California ("District Court"). The District Court had jurisdiction to hear Respondent's case under 28 U.S.C. §§ 1331 and 1338. Petitioner denied Respondent's contention and filed counterclaims seeking a declaratory judgment that Petitioner's distal radius fracture fixation system does not infringe claims of the '839 patent and that the claims of the '839 patent are invalid and unenforceable.

Petitioner then moved for summary judgment of non-infringement. In its motion, Petitioner argued that under a proper construction of the last element of claim 1—"said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate"—the accused products did not infringe. Petitioner explained that the last element of claim 1 was a means-plus-function element that required a hole **plus another structure** to perform the claimed functions of (1) allowing the pin to slide axially but preventing compression across the fracture, and (2) stabilizing the near end of the pin against displacement in the plane of the plate. According to the Applicant's disclosure to the public in the patent's specification, the structures for performing the claimed functions are: (1) a hole with a **slot** for "preventing disengagement"; (2) a **threaded hole** to engage threaded pins; (3) holes used with

locking means, such as a locking nut; (4) an **undersized hole with a cut** for holding the pin; (5) a **slotted, undersized hole** for locking the pin; and (6) a hole used with one or more **threaded or slotted locking studs.** Supp. App. at SA-6. Because the accused products lack any additional structure working in combination with a hole, the accused products could not infringe claim 1 of the '839 patent as a matter of law.

Respondent opposed the summary judgment motion by arguing, in part, that, contrary to the Applicant's "agreement" with the Patent Office, the last element of claim 1 was not written in means-plus-function format. As such, Respondent argued that mere holes performed the claimed functions of allowing the pin to slide axially and stabilizing the pin to prevent displacement in the plane of the plate.

The District Court adopted Petitioner's claim construction position and determined that the claim element "said holes in said plate providing means for [performing two specified functions]" was written in means-plus-function format. App. at 35a-39a. Thus, this claim element required a structure in addition to a hole for performing the claimed functions. *Id.* Because the accused products have only holes, the District Court granted Petitioner's motion for summary judgment of non-infringement. *Id.*; *see also* App. at 18a-19a.

The Federal Circuit's Disposition

Respondent appealed the District Court's grant of summary judgment of non-infringement to the Federal Circuit. In doing so, Respondent argued that the last element of claim 1 was not written in means-plus-function format and as properly interpreted required mere holes to perform the claimed functions. The Federal Circuit agreed. Dismissing both the use of "means for performing a specified function" language in claim 1 and the Applicant's express written "agreement" with the Patent Office, the Federal Circuit reversed the District Court's grant of summary judgment. App. at 7a-11a. In essence, the Federal Circuit allowed Respondent to redraft a critical part of the claim—omitting the need for an additional structure, in combination with the holes, to perform the claimed functions. Petitioner timely requested rehearing *en banc*, which was denied on March 10, 2008. App. at 43a-44a.

REASONS FOR GRANTING THE PETITION

The Federal Circuit's decision to apply as only a rebuttable presumption the statutory mandate embodied in 35 U.S.C. § 112, ¶ 6 is contrary to the clear language of that statute. It conflicts with well-established principles of statutory interpretation outlined by this Court.

Congress enacted § 112, ¶ 6 to allow patent applicants to define their inventions in terms of functional language. As a consequence of doing so, however, the applicant's patent claims would be limited to structures, or equivalents, the applicant described

in the specification as performing the claimed functions. 35 U.S.C. § 112, ¶ 6. This statutory safeguard was put in place so that both the patent owners and the public at large would be able to ascertain, on the public record, the scope of the patent's protection.

With little fanfare or discussion of the issue, the Federal Circuit has developed a judicial rule that § 112, ¶ 6 only applies presumptively when the patent applicant invokes the statutory "means for performing a specified function" language. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed. Cir. 1991) (holding that § 112, ¶ 6 applies even when the claim recites some structure); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996) (stating that "use of the term 'means' (particularly as used in the phrase 'means for') generally invokes section 112(6) . . ."); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed. Cir. 1996) (holding that "the use of the word 'means' triggers a presumption that the invention used this term advisedly to invoke the statutory mandates for means-plus-function clauses"); *see also* William F. Lee & Eugene M. Paige, *Means Plus and Step Plus Function Claims: Do We Only Know Them When We See Them?*, 80 J. Pat. & Trademark Off. Soc'y 251, 257-63 (1998). In particular, under Federal Circuit case law if "sufficient structure" is recited in the claim element, the claim element is not interpreted under the statutory mandate of § 112, ¶ 6. *See, e.g., Biomedino*, 490 F.3d at 950; *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997).

Over the years, the Federal Circuit's application of this statutory provision has generated uncertainty regarding the scope of any claim element that invokes the statutory "means for performing a specified function" language. *See, e.g.*, Kimberly A. Moore, Markman *Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 242-43 (2005) (noting that the Federal Circuit's means-plus-function law is difficult to apply and "[t]his may support adoption of a black letter application standard; namely, if the term uses the word 'means,' it is a means-plus-function term . . ."); William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 252, 266-68 (noting that "although the broad outlines are now acquiring some definition, the law of what constitutes a means-plus-function claim is fraught with uncertainty . . ."). But, patent owners and the public at large have a critical need to understand the scope of a patent's protection based upon the public written record. Certainty in the application of 35 U.S.C. § 112, ¶ 6 would better allow patent owners to determine if a competitor truly was or was not infringing. Likewise, knowing whether or not interpretation under § 112, ¶ 6 would apply to a claim element would allow the public to better ascertain what activity may be an infringement or non-infringement for business planning purposes.

In this case, the Federal Circuit has generated greater uncertainty with its decision below by taking a further step away from § 112, ¶ 6 and applying special rules which ignore Patent Office agreements in the interpretation of patents. *Compare* App. at 6a-10a (rewriting Applicant's bargained-for-agreement) *with United States v. Joseph A. Holpuch Co.*, 328 U.S. 234,

238-40 (1946) (holding claim for damages barred where respondent failed to "abide by the appeal provisions of Article 15 of the contracts" because "[t]o do otherwise is to rewrite the contract") *and Front Row Theatre, Inc. v. Am. Mfr. Mutual Ins. Cos.*, 18 F.3d 1343, 1347 (6th Cir. 1994) (plaintiff not entitled to insurance coverage where cause of damage was specifically excluded from contract). Despite this Court's pronouncement that patents are like any other written document, the Federal Circuit construed Respondent's patent claims in a manner directly contrary to how any other court would interpret written or legal documents. In nullifying the very agreement that the Applicant made with the Patent Office in order to obtain allowance of its patent, the Federal Circuit called into question the very nature of the patent prosecution process and its public notice function.

I. THE FEDERAL CIRCUIT'S STATUTORY CONSTRUCTION IS CONTRARY TO THIS COURT'S PRECEDENT

Review by this Court is necessary so that this Court can address the proper statutory interpretation of 35 U.S.C. § 112, ¶ 6. The current construction adhered to by the Federal Circuit impermissibly inserts a judicially-created exception into the otherwise clear language of this statutory provision. As currently interpreted, the mandatory provisions of 35 U.S.C. § 112, ¶ 6 become merely a rebuttable presumption. The Federal Circuit's statutory construction has created uncertainty regarding the scope of a patent owner's rights that needs to be addressed by this Court.

A. The Federal Circuit's Interpretation Of § 112, ¶ 6 Resurrects The Problems Identified By This Court In *Halliburton*

In 1952, Congress enacted Section 112, paragraph 6 as "a targeted cure to a specific problem." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28 (1997). Specifically, this Court had determined previously in *Halliburton* that claim elements written in "means" or functional language did not meet the definiteness requirement embodied in § 112. *Halliburton*, 329 U.S. at 10. In prohibiting the use of "means" language, this Court delineated numerous problems with allowing applicants to claim their alleged invention with purely functional language. Namely, this Court was concerned that such claim elements were too broad and ambiguous to meet the goals of the Patent Act:

> Where the ingredients are all old the invention . . . consists entirely in the combination, and the requirement of the Patent Act that the invention shall be fully and exactly described applies with as much force to such an invention as to any other class, because if not fulfilled all three of the great ends intended to be accomplished by that requirement would be defeated. . . . (1.) That the government may know what they have granted and what will become public property when the term of the monopoly expires. (2.) That licensed persons desiring to practice the invention may know, during the term, how to make, construct, and use the invention.

> (3.) That other inventors may know what part of the field of invention is unoccupied.

Halliburton, 329 U.S. at 10 (*quoting Gill v. Wells*, 89 U.S. 1, 25-26 (1874)); *see also id.* at 12 ("Under these circumstances the broadness, ambiguity, and overhanging threat of the functional claim of [the patent-in-suit] become apparent.").

In response to *Halliburton*, Congress enacted § 112, ¶ 6. *See, e.g., Warner-Jenkinson*, 520 U.S. at 28. This new statutory provision allowed patent applicants to use "means" language in their patent claims. But, to cure the definiteness problems outlined by this Court, Congress provided an express mandate regarding the construction of these claim elements. Under the statute, an applicant is allowed to claim his or her invention "as a means or step for performing a specified function," but if the applicant does so "such claim **shall be construed** to cover the corresponding structure, material, or acts described in the specification or equivalents thereof." 35 U.S.C. § 112, ¶ 6 (emphasis added). In other words, "[s]ection 112 thus permits means-plus-function language in a combination claim, but with a 'string attached.' The 'attached string' limits the applicant to the structure, material, or acts in the specification and their equivalents." *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1042 (Fed. Cir. 1993).

The patent statute is clear and mandatory. If an applicant writes a claim element in "means for performing a specified function" language, that claim element must be interpreted under 35 U.S.C. § 112, ¶ 6,

i.e., the claim element must be limited to the structures in the specification (or equivalents) for performing the claimed functions. Despite this clear mandate, over time the Federal Circuit has developed a loophole for applicants dissatisfied with the claims they negotiated for during patent prosecution. Under the Federal Circuit's case law, if an applicant uses the words "means for" with the recitation of functions to be performed in the claim element, then 35 U.S.C. § 112, ¶ 6 only creates a rebuttable presumption. *See, e.g., Biomedino*, 490 F.3d at 950. If, however, the claim element is written in the language permitted under § 112, ¶ 6 but also recites "sufficient structure," according to the Federal Circuit the claim element is no longer interpreted under the statute. *See, e.g., Sage Prods.*, 126 F.3d at 1427-28.

Unfortunately, what constitutes "sufficient structure" is often times uncertain, debatable, and open to subjective determinations. *Compare Unidynamics Corp. v. Automatic Prods., Int'l, Ltd.*, 157 F.3d 1311, 1319 (Fed. Cir. 1998) (interpreting "spring means" as subject to § 112, ¶ 6) *with Turbocare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec., Co.*, 264 F.3d 1111, 1120-21 (Fed. Cir. 2001) (declining to interpret "compression spring means" as subject to § 112, ¶ 6).[1]

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1. For additional examples of the arbitrary and capricious results stemming from the application of the Federal Circuit's judicially-created exception to § 112, ¶ 6 *compare Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375-76 (Fed. Cir. 2003) (finding insufficient structure in the claim element "means of booting said digital computer, said means of booting **including** a first set of commands, said first set of commands resident on said storage device . . ., and a second set of commands resident on a

(Cont'd)

Moreover, allowing an applicant to escape the ambit of § 112, ¶ 6 can lead to, as in this case, an impermissible broadening of the patent's scope such that the patent claims will cover products or processes that patent law did not contemplate.[2] Thus, the Federal Circuit has

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(Cont'd)

storage device external to said digital computer . . ." in part because use of "'including'—an open term— . . . suggests that the two sets of 'commands' are not sufficient structure; rather, something else is needed") (emphasis added) *with Searfoss v. Pioneer Consol. Corp.*, 374 F.3d 1142, 1145-46, 1149 (Fed. Cir. 2004) (finding sufficient structure in the claim element "actuation means for connecting said tension bail to said extension assembly . . . said actuation means **including** first and second pivot connections . . . and a midpoint on said respective first and second extension bail legs" despite the applicant's use of the open term "including") (emphasis added) and *compare also Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1272-73 (Fed. Cir. 1999) ("first switch means" and "memory selection second switch means" do not recite sufficient structure even though structures in the specification were merely switches) *with MediaCom Corp. v. Rates Tech., Inc.*, 4 F. Supp. 2d 17, 27 (D. Mass. 1998) ("switch means" recites sufficient structure for performing the claimed functions, *i.e.* a switch). Indeed, when faced with the same exact claim element, judges of the Federal Circuit cannot even agree on how to apply their judicially created-exception. *See Cole v. Kimberly-Clark Corp.*, 102 F.3d 524 (Fed. Cir. 1996) (majority finding "perforation means" contained a sufficient recital of structure; dissent finding "perforation" was not a sufficient recital of structure).

2. This case typifies the broadening effect resulting from an applicant's escape of § 112, ¶ 6. Had the Federal Circuit properly interpreted the last element of claim 1, Respondent's

(Cont'd)

created the very problems outlined by this Court in *Halliburton*. As noted above, the *Halliburton* Court warned that use of purely functional claim language (without the safeguards later enacted by Congress) was problematic because the government may not know "what they have granted and what will become public property when the term of the monopoly expires." *Halliburton*, 329 U.S. at 10. Likewise, licensees will not know how to practice the invention nor will other inventors know "what part of the field of invention is unoccupied." *Id.*

This case exemplifies these very real problems. Here, the Patent Office expressly agreed with the Applicant that the last element of claim 1 was to be written in means-plus-function format. Supp. App. at SA-7. The Applicant, moreover, expressly indicated to the Patent Office that the claim element was amended in accordance with the Applicant's agreement with the

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(Cont'd)

patent would have been limited to a plate with a hole **plus another structure** that worked in combination with the hole to allow a pin to slide axially but preventing compression across the fracture and to stabilize the pin. But, since the Federal Circuit determined that the last element of claim 1 should not be interpreted under § 112, ¶ 6, Respondent's patent was broadened to include all plates with any type of hole that would allow a pin to slide axially and stabilize the pin against displacement in the plane of the plate. In other words, the Federal Circuit allowed Respondent to broaden a critical claim element, namely eliminating the requisite additional structure for performing the claimed functions (*e.g.* a hole with a slot, threaded hole with threaded pin, a hole with locking means, etc.). Respondent thereby escaped summary judgment of non-infringement against it.

Patent Office. Supp. App. at SA-11. Thus, when the '839 patent issued, the Patent Office and competitors in the field had every reason to believe, based on the fixed written record, that the last element of claim 1 was written in means-plus-function format. They had no reason to believe that years later Respondent would surprise everyone by arguing the complete opposite. The Federal Circuit, years after the '839 patent issued, determined that the last element of claim 1 is not written in means-plus-function format. App. at 7a-10a. Petitioner certainly had no way of knowing that § 112, ¶ 6 would **not** apply to the applicable means-plus-function claim element until the Federal Circuit ruled so nearly eight years after the '839 patent issued.

Indeed, contrary to the Federal Circuit's finding that holes are the only required structure, the Applicant and the Patent Office expressly agreed that the Applicant needed to "better defin[e] the holes" in order to obtain allowance. Supp. App. at SA-7. But, holes by themselves would not need better defining because "holes" are "holes." This conclusion is further buttressed by the specification which discloses six structures used in combination with a hole for performing the claimed functions: (1) a slot; (2) a threaded hole; (3) a locking nut; (4) an undersized hole; (5) a slotted, undersized hole; and (6) threaded or slotted studs. Supp. App. at SA-6.

Using functional language to delineate the boundaries of an invention is problematic. This Court in *Halliburton* noted some of these problems. Congress, as a result, enacted safeguards to ensure that claim elements written in "means for performing a specified function" language did not suffer these aforementioned

problems. The Federal Circuit's judicially-created presumptive—rather than mandatory— application of § 112, ¶ 6 weakens these safeguards and in turn resurrects the very problems that concerned this Court years ago. As a result, this Court's guidance is needed to properly interpret 35 U.S.C. § 112, ¶ 6.

B. Using A Judicially-Created Presumption To Allow Judicial Exceptions To The Mandate Of 35 U.S.C. § 112, ¶ 6 Violates Basic Principles Of Statutory Interpretation

The Federal Circuit's construction of § 112, ¶ 6 violates basic principles of statutory interpretation enunciated by this Court, namely this Court's instruction that exceptions should not be implied to statutory provisions. Just as these basic principles of statutory interpretation apply to any other statutory enactment, these same principles should apply with equal force to the provisions of the Patent Act.

As noted above, section 112 explicitly governs the claim interpretation of claim elements written in means-plus-function format. Specifically, § 112, ¶ 6 provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim **shall be construed** to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, ¶ 6 (emphasis added).

This statutory provision is clear. It mandates interpretation under § 112, ¶ 6 when an applicant writes a claim element in "means for performing a specified function" language. It provides no exceptions. *See United States v. Rutherford*, 442 U.S. 544, 552 (1979) ("Exceptions to clearly delineated statutes will be implied only where essential to prevent 'absurd results' or consequences obviously at variance with the policy of the enactment as a whole."); *see also Lexecon, Inc. v. Milberg Weiss Bershad Hynes & Lerach*, 523 U.S. 26, 35 (1998) (noting that the statutory instruction "comes in terms of the mandatory 'shall,' which normally creates an obligation impervious to judicial discretion").

Notably, the statute does not provide that § 112, ¶ 6 is inapplicable when there is some recital of structure. *See, e.g., Laitram*, 939 F.2d at 1536 ("The recitation of some structure in a means plus function element does not preclude the applicability of section 112(6)."). Rather, the plain meaning of § 112, ¶ 6 requires that claim language using the words "means for," plus the recital of functions to be performed, shall be interpreted in accordance with 35 U.S.C. § 112, ¶ 6 in all circumstances. That the claim language may also describe one of the structures which may perform part or all of the claimed functions does not change the analysis. *Cf.* William F. Lee & Eugene M. Paige, 80 J. Pat. & Trademark Off. Soc'y at 266 n.106 (noting that although the Federal Circuit opted for a different interpretation, the use of the word "may" in the statute could be interpreted to "permit the patentee to use a means-plus-function claim form with the option of reciting structure"). In these fact situations, the structure described in the claim language may simply be one of or part of one of the

structures from the specification for the court to consider in construing the means-plus-function language. This result provides a consistent interpretation, without any loopholes, in all circumstances. *See* Kimberly A. Moore et al., *Patent Litigation And Strategy* 321-24 (2d ed. 2003) (suggesting that a "black letter rule" would be better than inconsistencies caused by current law); Kimberly A. Moore, 9 Lewis & Clark at 243 (same).

Nevertheless, as discussed above, the Federal Circuit does not apply § 112, ¶ 6 if the Federal Circuit determines that a claim element recites "sufficient structure." The creation of this judicial exception is contrary to the statutory mandate that claim elements "expressed as a means or step for performing a specified function . . . shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof." Indeed, this judicially-created exception conflicts with this Court's mandate that "federal courts do not sit as councils of revision, empowered to rewrite legislation in accord with their own conceptions of prudent public policy." *Rutherford*, 442 U.S. at 555.

The need for this Court's guidance is compelling. Recently, this Court has indicated a willingness to offer guidance in the construction of federal statutes that significantly affect patent rights. *See Merck KGaA v. Integra LifeSciences I, Ltd.*, 545 U.S. 193, 202-08 (2005); *see also Eli Lilly & Co. v. Medtronic, Inc.*, 496 U.S. 661 (1990) (interpreting 35 U.S.C. § 271(e)(1)). For example, in *Merck KGaA*, the Federal Circuit narrowly construed § 271(e)(1), the statutory infringement exemption for

acts "reasonably related to the development and submission of information under a Federal law" which regulates drug use. *Merck KGaA*, 545 U.S. at 205-06; 35 U.S.C. § 271(e)(1). Despite the breadth of § 271(e)(1), the Federal Circuit created uncertainty by limiting the statutory exemption to activities which actually produced information that ultimately was submitted to the FDA. *Merck KGaA*, 545 U.S. at 201, 206-07. The Federal Circuit interpreted § 271(e)(1) in this manner even though the statutory language provided no such limitation. The uncertainty created by this interpretation, in turn, unfairly expanded a patent owner's rights by allowing a patent owner to accuse exempted activities as infringement.

This Court reversed the Federal Circuit's statutory construction because the research process is often fraught with uncertainty. *Id.* at 206-07. In other words, not every course of experimentation will lead to a FDA submission. *Id.* As a result, the scope of the exemption as interpreted by the Federal Circuit was uncertain—one could never know at the time experimentation began if a FDA submission would ultimately be made and therefore if the exemption would apply. *Id.* In light of the statute's language (which did not narrowly limit the exempted activities as held by the Federal Circuit), this Court concluded that:

> There is simply no room in the statute for excluding certain information from the exemption on the basis of the phase of research in which it is developed or the particular submission in which it could be included.

Id. at 202.

Similarly, here, the scope of 35 U.S.C. § 112, ¶ 6 vastly impacts the scope of a patent owner's patent claims—the most critical part of a patent granting monopoly rights. The current interpretation of 35 U.S.C. § 112, ¶ 6, like the interpretation given to § 271(e)(1) by the Federal Circuit in *Merck KGaA*, creates uncertainty. Whereas in *Merck KGaA* one could never be certain if its activity fell under the statutory exemption until years later, here one could never be certain if its activity is infringing because it is impractical to know in some circumstances, like here, if a claim element avoids § 112, ¶ 6, until the Federal Circuit hangs its hat on analysis of whether the claim element recites "sufficient structure," whatever that means. The Federal Circuit's application of § 112, ¶ 6 has the effect of allowing a patent owner to expand improperly its patent rights in some situations and prevent competitors from engaging in lawful activity.

The Supreme Court has not yet addressed the proper interpretation of 35 U.S.C. § 112, ¶ 6. Petitioner believes that it is now appropriate to do so. The Federal Circuit's current construction is contrary to principles of statutory interpretation. This construction leads to the very problems of claim uncertainty, ambiguity and unwarranted broadness that caused this Court to initially question the appropriateness of "means for performing a specified function" claim language before the enactment of 35 U.S.C. § 112, ¶ 6.

II. THE FEDERAL CIRCUIT CREATED AN INTRA-CIRCUIT SPLIT REGARDING THE PUBLIC NOTICE FUNCTION OF A PATENT'S PROSECUTION HISTORY

The need for this Court's guidance is further augmented by the Federal Circuit's intra-circuit split regarding the proper role of a patent's prosecution history in the claim construction process. This Court has previously made clear that a patent is no different from any other legal instrument. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-90 (1996). Like any other written instrument, such as a contract, a patent is to be interpreted by the judge and it is "to be construed . . . according to its tenor." *Id.* at 388. In line with this directive, the Federal Circuit generally interprets a patent consistently with the intrinsic evidence, which includes the prosecution history. *See, e.g., Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1358-59 (Fed. Cir. 2006); *Spring Window Fashions LP v. Novo Indus. L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003); *Sage Prods.*, 126 F.3d at 1425, 1432. Indeed, the Federal Circuit has held that the prosecution history is to be used for the precise issue here—determining whether 35 U.S.C. § 112, ¶ 6 applies. *See Cole*, 102 F.3d at 531-32. But, in this case, the Federal Circuit reversed course by interpreting the patent claim at issue in direct contravention of an explicit agreement between the Patent Office and the Applicant. App. at 7a-10a; *see also* Supp. App. at SA-7. This type of intra-circuit disagreement within the court with exclusive jurisdiction over patent cases is problematic, especially given that claim construction is an issue that arises in nearly every patent case.

This Court has not yet delineated a complete framework for judges to follow when construing patent claims. In this absence, the Federal Circuit has enumerated a general set of principles for the lower courts to follow. Of importance here, is the overarching principle that patent claims are generally to be interpreted in light of the intrinsic evidence, *i.e.*, the patent and its corresponding prosecution history. *See Vitronics Corp.*, 90 F.3d at 1582-83. Indeed, the Federal Circuit has repeatedly emphasized the importance of the prosecution history in claim interpretation:

> [The prosecution history] contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by an applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of **critical significance** in determining the meaning of the claims.

Id. at 1582 (emphasis added); *see also Cole*, 102 F.3d at 531 ("We decide on an element-by-element basis, based upon the patent and prosecution history, whether § 112, ¶ 6 applies."). In short, the very "purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution." *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (internal quotations omitted).

In light of the importance attributed to the prosecution history, the Federal Circuit routinely binds an applicant to any agreement between the applicant

and the Patent Office as memorialized in the prosecution history. *See, e.g.*, *Schoenhaus*, 440 F.3d at 1359 ("If the additional limitation of rigidity in the Examiner's Amendment was improper or unnecessary, plaintiffs should have raised this issue by appeal before the PTO."); *Sage Prods.*, 126 F.3d at 1432 (stating that "[a] patentee is not free to retrade or renege on a deal struck with the PTO during patent prosecution"); *cf. Festo*, 535 U.S. at 734-41 (patentee presumptively bound under doctrine of prosecution history estoppel by subject matter surrendered during prosecution). Failure to so bind the applicant would completely vitiate the public notice function served by the applicant's statements in the prosecution history. *See Spring Window*, 323 F.3d at 995 (holding that "[w]ere we to accept [the patentee's] position, we would undercut the public's reliance on a statement that was in the public record and upon which reasonable competitors formed their business strategies."); *see also Sage Prods.*, 126 F.3d at 1425.

Even though all legal instruments should be interpreted consistently with their intrinsic evidence and even though the Federal Circuit's previous case law illustrated a propensity for doing just that, the Federal Circuit has now deviated from this well-established principle. As explained above, in negotiating for his patent, the Applicant and the Patent Office expressly agreed in writing that the last element of claim 1 would be written in means-plus-function format **to obtain issuance of the patent**. Supp. App. at SA-7. The Applicant then amended his patent claim to include the agreed-to statutory "means for performing a specified function" language in the patent claim, and told the Patent Office that he made the amendment in accordance with their agreement. Supp. App. at SA-9-SA-11.

To avoid a finding of non-infringement, Respondent persuaded the Federal Circuit to allow it to renege on the Applicant's deal with the Patent Office and now some eight years later to interpret the claim element **not** as a means-plus-function element. App. at 7a-10a; *see also* Supp. App. at SA-7. In essence, the Federal Circuit allowed Respondent to rewrite a critical element of its patent claim in order to broaden impermissibly the scope of the Applicant's bargained-for-agreement with the Patent Office. In doing so, the Federal Circuit created an intra-circuit split on how to handle what happened before the Patent Office. This is problematic because the public can no longer be certain that an applicant will be bound by his or her bargained-for-agreement with the Patent Office, and consequently the public can no longer be certain about the scope of protection afforded by a patent.

A court cannot rewrite a contractual provision to cover a situation that was expressly excluded from the contract. *See, e.g., Holpuch*, 328 U.S. at 238-40 (holding claim for damages barred where respondent failed to "abide by the appeal provisions of Article 15 of the contracts" because "[t]o do otherwise is to rewrite the contract"); *Front Row Theatre*, 18 F.3d at 1347 (plaintiff not entitled to insurance coverage where cause of damage was specifically excluded from contract); *cf. United States v. Am. Surety Co.*, 322 U.S. 96, 101-02 (1944) ("[W]e are not justified in rewriting the clear provisions of the contract to include what might well have been but was not inserted . . ."); *Am. Capital Corp. v. Fed. Deposit Ins. Corp.*, 472 F.3d 859, 865 (Fed. Cir. 2006) ("We cannot rewrite a contract or insert words to which a party has never agreed."). Analogously, a court

cannot rewrite patent claims to cover a product or process that the applicant expressly excluded from the patent's scope during the negotiation process with the Patent Office to obtain the patent grant in the first place. This Court's guidance is needed to reaffirm the binding affect of an applicant's bargained-for-agreement with the Patent Office.

CONCLUSION

To give proper direction to the Federal Circuit and the public on patent interpretation, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED JANUARY 29, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1327

TRIMED, INCORPORATED,

Plaintiff-Appellant,

v.

STRYKER CORPORATION,

Defendant-Appellee.

Appeal from the United States District Court for the Central District of California in case no. 06-CV-1918, Judge Manuel L. Real.

DECIDED: January 29, 2008

Before LINN, DYK, and MOORE, *Circuit Judges*.

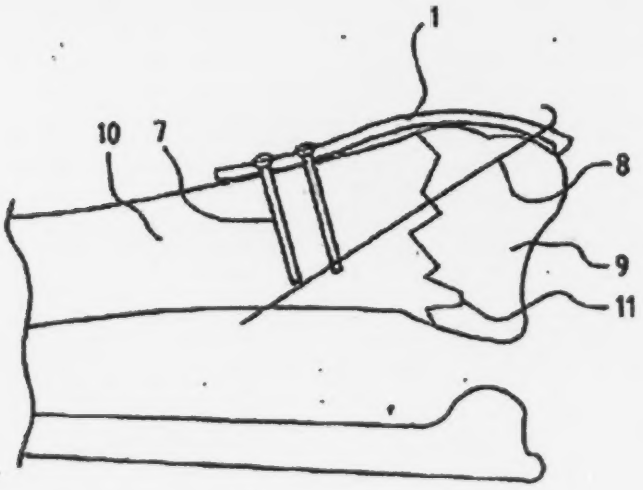
MOORE, *Circuit Judge*.

Plaintiff-appellant TriMed, Inc. (TriMed) appeals the summary judgment of noninfringement granted in favor of defendant-appellee Stryker Corporation (Stryker) by the United States District Court for the

Central District of California. Because the district court construed the relevant claim language incorrectly, we reverse.

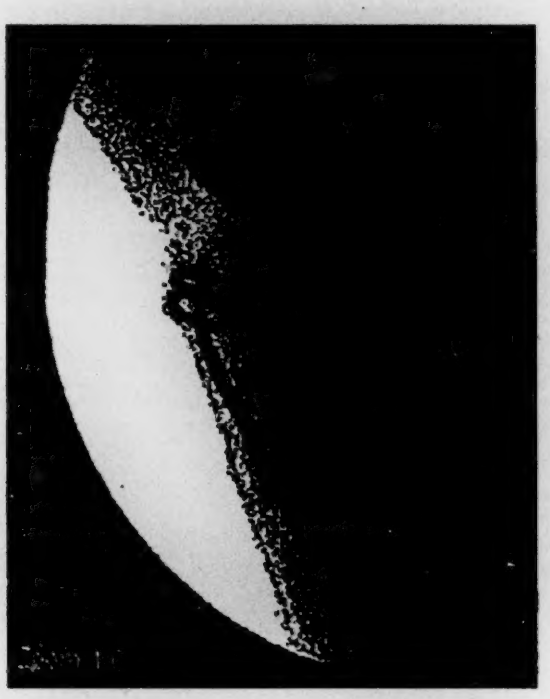
BACKGROUND

TriMed owns U.S. Patent No. 5,931,839 ('839 patent), which pertains to an implantable device for fixing bone fractures using screws, pins, and a plate with holes on one end for receiving screws and on the opposite end for receiving pins. In one embodiment of the '839 patent, the plate is fitted across a bone fracture such that the pin holes are positioned over the fractured bone fragment and the screw holes are positioned over the stable bone fragment. The screws affix the plate to the stable bone fragment. The pins fixate the fracture by passing through the pin holes of the plate, traversing the fracture such that the pins penetrate the fractured bone fragments and embed in the stable bone fragment. Figure 5 of the '839 patent illustrates this embodiment:



Appendix A

Stryker manufactures and sells implantable wrist fracture fixation devices that also involve screws, pins, and plates with holes. The following x-ray depicts the implantation of one such device:



As shown, Stryker's plate has been implanted on the distal radius. Pins have been inserted distally through the fractured bone fragment at an angle into the stable bone fragment. Screws have been inserted proximally to secure the plate to the stable bone fragment.

Appendix A

TriMed sued Stryker, alleging that Stryker's wrist fracture fixation devices infringe the '839 patent. Claim 1, the only independent claim at issue, reads as follows:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions, fastening means for securing one end portion of said plate to stable bone, at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin, the opposite, near end of said pin being adapted for extending from the fractured bone fragment, said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate, *said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.*

'839 Patent col.6 ll.17-32 (emphasis added).

Stryker moved for summary judgment of noninfringement, asserting that the phrase, "said holes in said plate providing means for allowing the pin to slide

axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate," is a means-plus-function limitation governed by 35 U.S.C. § 112 ¶ 6. Stryker argued, based upon two separate grounds, that this means-plus-function limitation is not present in the accused devices. First, according to Stryker, the language at issue requires surgeons to perform the functions of "allowing the pin to slide axially therein but preventing compression across the fracture" and "stabilizing said near end of the pin against displacement in the plane of the plate." Because, Stryker contended, its accused devices do not by themselves perform the claimed functions and that it does not supply the surgeons who may use the devices to perform the claimed functions, it cannot be held liable for infringement. Second, Stryker argued that the only corresponding structures disclosed in the specification of the '839 patent for performing the claimed functions are "hole[s] plus some other structure." As the accused devices contain holes and nothing more, Stryker asserted that it did not infringe on the '839 patent.

Adopting Stryker's proposed claim construction and signing without any modification Stryker's Rule 56 Statement of Facts and Conclusions of Law, the district court entered summary judgment of noninfringement against TriMed. TriMed timely appealed, and we have jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a)(1).

Appendix A

DISCUSSION

I.

The task of determining whether the relevant claim language contains a means-plus-function limitation is, as with all claim construction issues, a question of law that we review de novo. *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1455-56 (Fed. Cir. 1998) (en banc). Use of the word "means" in claim language creates a presumption that § 112 ¶ 6 applies. *See Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996). If, in addition to the word "means" and the functional language, the claim recites sufficient structure for performing the described functions in their entirety, the presumption of § 112 ¶ 6 is overcome—the limitation is not a means-plus-function limitation. *See Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1360 (Fed. Cir. 2004) ("[T]he fact that a particular mechanism . . . is defined in functional terms is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6)."); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed. Cir. 1997). Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure. *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1376 (Fed. Cir. 2003); *see also Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed. Cir.

2000) (finding that "baffle means" defeated the § 112 ¶ 6 presumption because "the term 'baffle' itself imparts structure").

The district court erred in concluding that the language at issue in claim 1 was means-plus-function language that invoked § 112 ¶ 6. To be sure, the claim discloses functions for the holes—allowing a pin to slide axially through the pin plate while preventing compression across the bone fracture, and stabilizing the exposed end of the pin against displacement in the plane of the plate. As our precedent makes clear, the presence of the word "means" and the articulation of a function is not the end of the inquiry. Just as clearly, the claim articulates the structure for performing the claimed functions—the holes. The functional language defines the size and shape of the claimed holes. The interior of the holes must be shaped to allow pins to slide through axially while the boundaries of the holes must be sized appropriately to hold the pins in place and limit their movement across the plane of the plate. The claim language makes clear that the structure for performing these functions is the holes themselves.

Since the claim language clearly identifies the structure for performing the functions in claim 1, it was unnecessary and inappropriate for the court to employ § 112 ¶ 6 and to hold that there must be a structure in addition to the holes (such as a slot) for performing these functions. Even if we were to construe this as a § 112 ¶ 6 claim, the specification discloses an embodiment that has precisely the same structure that is found in the

accused devices. The specification states: "In one embodiment the pins 8 are bent over the superficial surface of the plate 1 as stated above." '839 Patent col.5 ll.24-25. The reference is to an earlier part of the specification, which stated that: "The rigidity of pin fixation of the fracture fragment is considerably improved by having it pass through one of the small holes 3 and possibly a tight slot 4 in the pin plate 1 which has been secured to the proximal fragment 10. After the pin 8 is placed, it can be bent over the superficial surface of the plate 1 to keep it from migrating."[1] *Id.* col.4 ll.56-61.

Stryker argues that the prosecution history of the '839 patent dictates that the claim limitation at issue does not recite sufficient structure for performing the described functions and instead must be read as requiring "hole [s] plus another structure." Specifically, Stryker points to an interview summary that states, "Agreement was reached that the expression of [the configuration of the pin to be attached to the plate in a sliding manner that prevents compression across the fracture] in a means-plus-function format and better defining the holes of the plate would distinguish over the prior art of record."[2] Because TriMed subsequently

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1. Additional structures for performing the claimed functions beyond mere holes, such as slots and other means for snap engagement of the pin to the plate, are recited in dependent claims not discussed in this opinion. *See, e.g.*, '839 Patent col.6 ll.36-39.

2. A statement that use of means-plus-function language would help overcome prior art does not magically transform

(Cont'd)

amended claim 1 to include the claim language in dispute, Stryker contends that the language must be construed as a means-plus-function limitation.

We disagree. While TriMed did use the word "means" in its amendment, its attorney remarks accompanying the amendment indicate that it intended for holes by themselves to constitute structure sufficient for allowing pins to slide axially through without compressing the fracture and stabilizing the pin from displacement across the plane of the plate. As the remarks put forth:

> The invention provides for stabilization of the end of the pin projecting from the fractured bone fragment without compromising the securing of the fractured bone segment to the stable bone segment without compression at the fracture. This is achieved by utilization of the pin plate 1 which has holes at one end portion for being fixed to stable bone while the opposite end has holes for engaging the protruding end of the pin, so as to prevent displacement of the protruding end of the pin in the plane of the pin plate and wherein the hole provides means for allowing the pin to slide axially in the hole in the pin plate but preventing compression across the fracture.

(Cont'd)
language that clearly does not meet our legal tests for § 112 ¶ 6 into means-plus-function language.

Nowhere in those remarks does TriMed suggest the importance of any structure in addition to holes, as Stryker would have us believe. *See Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996) (explaining that the claim drafter's "perfunctory addition of the word 'means' did nothing to diminish the precise structural character" of the claim limitation). The prosecution statement does not even suggest that structure in addition to holes is required.

For the foregoing reasons, the claim language at issue recites sufficient structure on its face for performing the claimed functions, and therefore, contrary to the district court's interpretation, does not involve a means-plus-function limitation.

II.

We review the district court's grant of summary judgment without deference, reapplying the same standard required of the court below. *Lacavera v. Dudas*, 441 F.3d 1380, 1382 (Fed. Cir. 2006). Summary judgment is appropriate only "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c).

Stryker's motion for summary judgment of noninfringement was premised solely upon reading the claim language at issue as a means-plus-function

limitation. Having properly construed the relevant claim language as falling outside the ambit of § 112 ¶ 6, we hold that Stryker has failed to demonstrate that there is no genuine issue of material fact that its accused devices do not infringe on the '839 patent. By Stryker's own admission, the structural limitation of holes in claim 1 is certainly present in its accused devices.[3]

Moreover, TriMed has adduced enough evidence to establish, at minimum, a genuine issue of material fact as to whether Stryker's accused devices perform the claimed functions. TriMed submitted a declaration from Dr. Leon Benson, an orthopedic hand surgeon, which stated that the holes in Stryker's accused devices perform both claimed functions based on his review of x-rays of the implanted Stryker plates and Stryker's operative technique manuals. TriMed also submitted a declaration from Dr. Robert Medoff, an orthopedic hand surgeon and the inventor behind the '839 patent, that stated that, based on an analysis of a product sample of Stryker's plates and its operative technique manual, pins can be slid axially through the pin holes in Stryker's

---

3. With a side-by-side comparison of figure 5 of the '839 patent and the x-ray of Stryker's implanted plate, it is hard to imagine any significant structural differences between the two. Indeed, Stryker was unable to point out any differences on appeal, only contending during oral argument that figure 5 does not show whether the pin has been inserted through a hole or a hole with some other structure. As the proper construction of claim 1 encompasses embodiments using holes to receive pins—with or without some other structure—this argument is unconvincing.

plates such that compressive force across a fracture is avoided, and that the holes are "small enough to secure the pin from lateral movement thus stabilizing the pin from translational displacement in the plane of the plate."

Stryker's only counterargument below, which the district court adopted—that it did not supply the surgeons who were purportedly required to perform the claimed functions of the '839 patent—is wholly unpersuasive. No credible reading of the claim language requires human input to perform the functions of the pin holes in TriMed's plate. Stryker's only response on appeal—that "the accused devices do not permit the end of the pin to be locked to the pin plate"—is similarly unavailing. Locking the pin to the plate is simply not a requirement of the claim language. Thus, because the summary judgment of noninfringement is inappropriate, we reverse.

CONCLUSION

Because the claim language of the '839 patent articulates sufficient structure for performing the functions of allowing pins to slide axially through the pin plate and stabilizing said pins from movement across the plane of the plate of the claimed invention, we determine that the district court improperly interpreted the pin holes claim limitation as governed by § 112 ¶ 6. In light of the proper claim construction, the grant of

summary judgment of noninfringement must be reversed. We remand for further proceedings consistent with our opinion and in view of the entire record.[4]

REVERSED AND REMANDED

4. Given our holding vacating the summary judgment of noninfringement, the time for discovery ought to be reinstated as originally scheduled in this case. The seventeen days of discovery should be fully restored.

APPENDIX B — JOINT STIPULATION OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED MARCH 28, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

Case No. CV-06-1918 R(SHx)

TRIMED, INC.,
a California corporation,

Plaintiff,

v.

STRYKER CORP.,
a Michigan corporation,

Defendant.

JOINT STIPULATION OF DISMISSAL OF STRYKER CORPORATION'S COUNTERCLAIM OF INVALIDITY WITHOUT PREJUDICE

THE PARTIES HEREBY AGREE AND STIPULATE TO THE FOLLOWING:

1. On March 28, 2006, TriMed, Inc. ("TriMed") filed its Complaint against Stryker Corporation ("Stryker") alleging infringement of U.S. Patent No. 5,931,839 ("the '839 patent").

2. Stryker answered on May 19, 2006, denying the Complaint, asserting affirmative defenses, and alleging counterclaims seeking declarations of noninfringement and invalidity.

3. TriMed filed its reply to Stryker's counterclaims on June 6, 2006.

4. On January 16, 2007, Stryker filed a motion for summary judgment asserting that Stryker does not infringe any asserted claim of the '839 patent either literally or under the doctrine of equivalents.

5. On March 19, 2007 ("March 19th Order"), the Court issued an Order granting Stryker's motion for summary judgment of noninfringement that the accused Stryker products do not infringe any asserted claims of the '839 patent, either literally or under the doctrine of equivalents. The Order further dismissed with prejudice TriMed's Complaint against Stryker.

6. The March 19th Order does not constitute a final judgment because it did not dispose of all the claims in the action. *See Pause Technology LLC v. Tivo Inc.*, 401 F.3d 1290 (Fed. Cir. 2005). Namely, the March 19th Order did not address Stryker's counterclaim that the claims of the '839 patent are invalid.

7. Accordingly, the parties jointly stipulate that Stryker's counterclaim of invalidity is hereby dismissed without prejudice.

Respectfully submitted,

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Attorneys for Defendant,
STRYKER CORPORATION

IT IS SO ORDERED

Dated: March 28, 2007

s/ Manuel Real
Honorable Manuel L. Real
Judge, United States District Court

APPENDIX C — MINUTES OF PROCEEDINGS OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA DATED MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES - GENERAL

CASE NO.: CV-06-1918-R Date: March 19, 2007

TITLE: TRIMED INC V. STRYKER CORP

PRESENT:

HON. MANUEL L. REAL, JUDGE

William Horrell	*Cindy Nirenberg*
Deputy Clerk	Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:
Mark Grossman
Robert Garretson

ATTORNEYS PRESENT FOR DEFENDANTS:
Robert Surrette
Morgan Tovey

PROCEEDINGS: Defendant's motion for summary judgment of noninfringement of '839 patent

The Court GRANTS the motion, and signs the proposed uncontroverted facts and conclusions of law, and the proposed judgment.

MINUTES FORM 90	*4 min*
CIVIL -- GEN	Initials of Deputy Clerk *WH*

APPENDIX D — JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

CASE NO. CV-06-1918 R(SHx)

TRIMED, INC.
a California corporation,

Plaintiff,

v.

STRYKER CORP,
a Michigan corporation,

Defendant.

JUDGMENT GRANTING DEFENDANT STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT

Date: March 19, 2007
Time: 10:00 a.m.
Hon. Manuel L. Real

[PROPOSED] JUDGMENT

Having fully considered Defendant Stryker Corporation's ("Stryker") Motion for Summary Judgment of Noninfringement of the '839 Patent, TriMed, Inc.'s

("TriMed") response thereto, Stryker's reply, the declarations, exhibits, and memoranda submitted therewith and the relevant authorities cited, and the arguments and materials presented at the hearing,

IT IS HEREBY ORDERED AND JUDGED AND DECREED:

1. The accused products do not infringe any asserted claim of U.S. Patent No. 5,931,839 either literally or under the doctrine of equivalents;

2. Defendant's Motion for Summary Judgment of Noninfringement of U.S. Patent No. 5,931,839, in favor of Stryker and against plaintiff TriMed, is granted; and

3. As summary judgment on all counts has been rendered against Plaintiff TriMed, Plaintiff TriMed's Complaint is hereby DISMISSED WITH PREJUDICE.

IT IS SO ORDERED

s/ Manuel L. Real
Hon. Manuel L. Real
UNITED STATES DISTRICT JUDGE

Dated: March 19, 2007

APPENDIX E — STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT SIGNED BY HON. MANUEL L. REAL ON MARCH 19, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

CASE NO. CV-06-1918 (SHx)

TRIMED, INC.
a California corporation,

Plaintiff,

v.

STRYKER CORP,
a Michigan corporation,

Defendant.

STATEMENT OF UNCONTROVERTED FACTS AND CONCLUSIONS OF LAW IN SUPPORT OF STRYKER'S MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT OF THE '839 PATENT

Date: March 19, 2007
Time: 10:00 a.m.
Hon. Manuel L. Real

Appendix E

Statement Of Uncontroverted Facts And Conclusions Of Law

Defendant Stryker Corp. ("Stryker") filed its Motion for Summary Judgment of Noninfringement of the '839 Patent on January 8, 2007 ("Motion"). In its Motion, Stryker contends that none of the accused products infringes any asserted claim of the U.S. patent no. 5,931,839 ("the '839 patent"), and plaintiff TriMed, Inc. ("TriMed") has not carried its burden of proving infringement.

The Findings of Fact Not Genuinely Disputed and Conclusions of Law In Support are set forth below. *See* Fed. R. Civ. P. 52.

I. FINDINGS OF FACT NOT GENUINELY CONTESTED

A. The Parties

1. Defendant Stryker is a Michigan corporation having a principal place of business in Kalamazoo, Michigan. Stryker develops, manufactures, and markets specialty surgical and medical products.

2. Plaintiff TriMed is a California corporation having a principle place of business in Valencia, California. TriMed designs and sells orthopedic medical devices for the fixation of fractures. TriMed is the alleged assignee of the '839 patent.

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B. The History Of The Case

3. TriMed filed its complaint of patent infringement against Stryker on March 28, 2006. ("Complaint," Docket No. 1.)

4. Stryker filed an answer, affirmative defenses, and counterclaims on May 19, 2006. ("Answer," Docket No. 17.)

5. TriMed filed a reply to Stryker's counterclaims on June 6, 2006. ("Reply," Docket No. 20.)

6. TriMed provided responses to Stryker's First Set of Interrogatories on September 27, 2006. (Ex. 1, Plaintiff's Responses To Defendants' *[sic]* First Set of Interrogatories.) On December 6, 2006, December 26, 2006, and January 10, 2007, TriMed supplemented its responses to Stryker's First Set of Interrogatories. (Ex. 2, Plaintiff's Supplemental Responses To Defendants' [sic] First Set of Interrogatories; Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories; Ex. 4, Plaintiff's Supplemental Response to Defendants' *[sic]* Interrogatory No. 2.)

C. The '839 Patent

7. The '839 patent relates to a plate having holes, screws, and pins for fixing broken bones. (Ex. 5, '839 patent.)

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8. Figures 1, 4, and 5 of the '839 patent, reproduced below, illustrate "a top view of a radio pin plate according to one embodiment of the invention," "an exploded view of one embodiment of the invention," and "one embodiment of the invention fixed to the radius," respectively. (*Id.* at Figures 1, 4, and 5; and 3:50-51, 55-58.)

9. One "primary objective" of the alleged invention of the '839 patent is to "satisfy the goal of providing rigid fixation of fracture fragments while allowing immediate motion of a joint." (*Id.* at 3:35-37.)

10. TriMed has asserted claims 1, 2, and 7-11 against Stryker. (Ex. 6, 8/23/06 Letter from J. Drake to B. Surrette.)

11. Claim 1, the only independent claim of the '839 patent, recites:

> An implantable device for fixation of at least one fractured bone fragment to a stable bone fragment, said implantable device comprising an implantable plate having opposite end portions,
>
> fastening means for securing one end portion of said plate to stable bone,
>
> at least one fixation pin for penetrating said at least one fractured bone fragment, and traversing a fracture for entering the stable bone fragment and for being secured therein at a stable fixation site at a far end of said fixation pin,
>
> the opposite, near end of said pin being adapted for extending from the fractured bone fragment,

> said near end of said pin being engageable in one of a plurality of holes in the other end portion of the plate,
>
> said holes in said plate providing means for allowing the pin to slide axially therein but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate.

(Ex. 5, '839 patent, claim 1.)

12. The '839 patent specification discloses that "the actual dimensions [of the holes and the pins] to be used are decided by the surgeon in each case based on the specific circumstances such as fracture site, fragment size, bone condition, etc." (*Id.* at 4:42-45.) In addition, "[t]he number of pins 8 used and their angle of insertion is decided in each case by the surgeon depending on the site and size of the specific fracture or fractures." (*Id.* at 5:60-63).

13. The specification of the '839 patent discloses:

> If a hole 3 with a slot 4 at the distal portion 5 of the plate 1 is used, the pin 8 will be placed first, and the plate 1 slid along the surface of the bone 10 to engage the pin 8. In one embodiment the entrance slot 4 is slightly undersized and capable of slight widening as the pin passes through the slot. This way, the

> plate 1 will "snap" as the pin 8 is passed into the slot 4, preventing disengagement.

(*Id.* at 5:3-10.)

14. The specification of the '839 patent discloses:

> In another embodiment, threaded pins 8 are used which pass through threaded holes within the plate 1.

(*Id.* at 5:25-27.)

15. The specification of the '839 patent discloses:

> Optionally the pins 8 are locked with locking means such as a locking nut. This provides fixation of the pin 8 in space in both a transverse plan (in the plan of the plate 1) and an axial plane (along the axis of the pin 8).

(*Id.* at 5:27-31.)

16. The specification of the '839 patent discloses:

> In a further embodiment (not shown) the openings 3 for receiving the pins 8 are slightly undersized with a cut extending from the hole 3 to the edge of the plate 1.

(*Id.* at 5:34-36.)

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17. The specification of the '839 patent discloses:

> Alternatively, a slotted hole 3 is used which joins a slightly undersized hole 3, instead of a slightly larger hole. In this circumstance, as the pin 8 is snapped into the hole 3, it is effectively locked into place.

(*Id.* at 5:45-48.)

18. The specification of the '839 patent discloses:

> In a further embodiment (not shown) the pin plate 1 is furnished with one or more threaded studs. The pin 8 is hooked around one stud and locked against the pin plate 1 with a threaded locking nut on the stud. Instead of locking the pin around the stud, the stud may have a slot for receiving the pin 8. After the pin has been placed in the slot a locking nut is screwed onto the stud to lock the pin 8 in the slot of the stud.

(*Id.* at 5:49-56.)

19. The specification of the '839 patent discloses:

> The fixation of the pins 8 at the pin plate 1 is accomplished in different ways in different embodiments of the invention. In one embodiment the pins 8 are bent over the

superficial surface of the plate 1 as stated above.

(*Id.* at 5:22-25.)

D. The Accused Products

20. TriMed alleges that the following plate models, used in conjunction with K-wires, infringe the asserted claims of the '839 patent: 54-25400, 54-25401, 54-25402, 54-25403, 54-25404, and 54, 25405. (Ex. 1, Plaintiff's Responses To Defendants' *[sic]* First Set Of Interrogatories, at 3; Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5.)

21. Two of the accused plates are reproduced below from photographs in a product brochure (Ex. 7, Bates Nos. SC 000455-462, Universal Distal Radius System, Operative Technique, 1000-405-017, Rev. A, 2005, at 00457):

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E. TriMed's Discovery Responses

22. In response to Stryker's Interrogatory No. 4 requesting that TriMed "set forth in a claim chart or otherwise explain how each element or limitation of each [asserted] claim is found in [the accused products]," TriMed stated:

> Regarding claim 1, Stryker's pin-plate products are implantable plate devices which fix at least one fractured bone fragment to a stable bone fragment. The plates have opposite end portions; the end portion with smaller holes typically used near or at the situs of the fractured bone fragment. Stryker sells fastening means (screw) for securing one end of the plate to the stable bone fragment. Stryker sells a fixation pin which pierces and passes through the fractured bone fragment. The fixation pin likewise pierces the stable bone, and the opposite end of the pin extends from the fractured bone fragment and into one of the holes at the fractured bone fragment end of the pin-plate, i.e., opposite the plate-end containing the screw(s). The pin is capable of moving in and/or out of the hole in the plate. The plate structure prevents the fracture from being compressed and stabilizes the pin.
>
> Stryker directly and literally infringes claim 2 of the '839 patent since, in addition to having all of the claim limitations of claim 1, one of

the holes in Stryker's pin-plate products is located in the plate and is near the entrance of the fixation pin into the bone fragment.

Stryker directly and literally infringes claim 7 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the pin-plate products sold by Stryker are shaped to conform to the shapes of the stable and fractured bone fragments.

Stryker directly and literally infringes claim 8 of the '839 patent since, in addition to having all of the claim limitations of claim 1, one of the fastening means for securing the Stryker pin-plate to the stable bone fragment can be a screw(s).

Stryker directly and literally infringes claim 9 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the Stryker fixation pin used with the Stryker pin-plate device is bendable back to the face of the pin-plate which prevents the pin and plate from separating from one another.

Stryker directly and literally infringes claim 10 of the '839 patent since, in addition to having all of the claim limitations of claim 1, Stryker's fixation pin contains a smooth portion to allow for the piercing and entry into the fractured bone fragment.

> Stryker directly and literally infringes claim 11 of the '839 patent since, in addition to having all of the claim limitations of claim 1, the Stryker fixation pins used with its pin-plate system are bendable by hand and have a diameter between 0.35 inch and 0.062 inch.

(Ex. 1, Plaintiff's Responses to Defendants' *[sic]* First Set of Interrogatories, at 3-5.)

23. In response to Stryker's Interrogatory No. 12 requesting the factual bases for TriMed's infringement allegations, TriMed stated:

> [Plaintiff] has observed Stryker's devices and products which infringe the '839 Patent offered for and/or sold at the American Academy Association of Hand Surgeons conference and other orthopedic meetings of doctors around the United States. Such devices infringe because they meet all of the limitations of claims 1, 2, 7, and 9-11.

(*Id.* at 10.)

24. In its supplemental response to Stryker's Interrogatory No. 4, TriMed stated:

> Stryker's pin-plate products, identified in response to Interrogatory No. 3, directly and literally infringe claims 1, 2, and 7 through 11. IN addition to the response regarding

> claim 1, Stryker's pin-plate products are implantable plate devices which fix at least one fractured bone fragment to a stable bone fragment. Stryker sells fastening means (screws) for securing one end of the plate to the stable bone fragment. Stryker sells a fixation pin which pierces and passes through the fractured bone fragment. Stryker's fixation pin likewise pierces the stable bone, and the opposite end of the pin extends from the fractured bone fragment and into one of the holes at the fractured bone fragment end of the pin-plate, i.e., opposite the end of plate containing the screw(s). Stryker's pin is capable of axially moving in and out of the hole in the plate; the size and shape of the holes limit the pin from migrating transversely in relation to the holes.

(Ex. 2, Plaintiff's Supplemental Responses to Defendants' *[sic]* First set of Interrogatories, at 5.)

25. In its supplemental response to Stryker's Interrogatory No. 12, TriMed stated:

> TriMed further states it has observed Stryker's devices and products which infringe the '839 Patent offered for and/or sold at the American Academy of Orthopaedic Surgeons instructional course during May 2004 in Chicago, Illinois. Such devices infringe

> because they meet all of the limitations of claims 1, 2, 7, 8, and 7-11 *[sic]*.

(*Id.* at 10.)

26. In its second supplemental response to Stryker's Interrogatory No. 4, TriMed stated:

> TriMed also believes Stryker product numbers 54-25402, 54-25403, 54-25404, and 54-25405 infringe the '839 Patent claims but Stryker has not provided requested samples to date and thus Plaintiff cannot complete its analysis. Upon receipt of said products, if TriMed determines these products infringe the claims of he '839 Patent, it will supplement this response.

(Ex. 3, Plaintiff's Supplemental and Second Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5.)

27. In its responses and supplemental responses to Stryker's Interrogatories, TriMed did not provide any evidence that surgeons have used or are using the accused products in an infringing manner. (*Id.* at 5; Ex. 1, Plaintiff's Responses to Defendants' *[sic]* First Set of Interrogatories, at 3-5, 10; Ex. 2, Plaintiff's Supplemental Responses to Defendants' *[sic]* First Set of Interrogatories, at 5, 10.)

Appendix E

II. CONCLUSIONS OF LAW

A. Legal Principles of Summary Judgment

28. Summary judgment "shall be rendered forthwith" where "there is no genuine issue as to any material fact" and "the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56 (c).

29. The Federal Circuit routinely affirms summary judgment of noninfringement. *See, e.g., Norian Corp. v. Stryker Corp.*, 432 F.3d 1356 (Fed. Cir. 2005); *Biagro Western Sales, Inc. v. Grow More, Inc.*, 423 F.3d 1296 (Fed. Cir. 2005); *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307 (Fed Cir. 2005); *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858 (Fed. Cir. 2004); *Phonometrics, Inc. v. Westin Hotel Co.*, 319 F.3d 1328 (Fed. Cir. 2003); *TechSearch L.C. v. Intel Corp.*, 286 F.3d 1360 (Fed. Cir. 2002); *Talbert Fuel Sys. Co. v. Unocal Corp.*, 347 F.3d 1355 (Fed. Cir. 2003); *Novartis Corp. v. Ben Venue Labs.*, 271 F.3d 1043 (Fed. Cir. 2001); *Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352 (Fed. Cir. 2001).

30. In a patent infringement action, "the accused infringer . . . is entitled to summary judgment, on the ground of noninfringement, by pointing out that the patentee failed to put forth evidence to support a finding that a limitation of the asserted claim was met by the structure in the accused devices." *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1578 (Fed. Cir. 1989). *See also Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986).

Appendix E

B. Legal Principles of Patent Infringement

31. To prove infringement of an asserted claim, TriMed must show, by a preponderance of the evidence, that every limitation in the claim appears in the accused product. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997); *see also Zygo Corp. v. Wyco Corp.*, 79 F.3d 1563, 1568 (Fed. Cir. 1996).

32. If an independent claim is not infringed, then any dependent claim depending from that independent claim cannot be infringed. *See Wahpeton Canvas Co. v. Frontier, Inc.*, 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989).

33. A claim for patent infringement involves a two-step inquiry. *Biagro Western*, 423 F.3d at 1301. First, the court construes the asserted claims as a matter of law. *Id.* After the claims are construed, the next issue is to determine whether the accused device infringes the properly construed claims. *Id.*

C. The Accused Products Do Not Infringe The '839 Patent As A Matter Of Law

34. The accused products do not infringe the '839 patent because they do not have "holes in said plate providing means for allowing the pin to slide axially but preventing compression across the fracture, and stabilizing said near end of the pin against displacement in the plane of the plate" as required by claim 1.

35. Because at least one claim limitation of independent claim 1 is not present in the accused products, there can be no infringement as a matter of law.

36. Claim elements that are written in means-plus-function form are interpreted in accordance with 35 U.S.C. § 112, ¶ 6, which provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

37. The statute permits a claim element to be expressed as a means for performing a specified function. *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1575 (Fed. Cir. 1991). "[T]he scope of such a claim is not limitless, but is *confined to structures expressly disclosed* in the specification and corresponding equivalents." *Id.* (emphasis added). *See also In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) *(en banc); Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1222 (Fed. Cir. 1996).

38. An equivalent structure in the context of the statute "results from an insubstantial change which adds nothing of significance to the structure, material,

or acts disclosed in the patent specification." *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993).

39. Literal infringement of a § 112, ¶ 6 claim limitation requires that the relevant structure in the accused product perform the identical function recited in the claim and be identical or "equivalent" to the corresponding structure in the specification. *See Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 (Fed. Cir. 1999). Under a modified version of the function-way-result methodology described in *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950), two structures may be "equivalent" for purposes of § 112, ¶ 6 if they perform the identical function, in substantially the same way, with substantially the same result. *See Odetics*, 185 F.3d at 1267. "When a court determines that the 'way' and/or 'result' is/are substantially different under a 35 U.S.C. section 112, paragraph 6 equivalents analysis, a patentee cannot prevail under the doctrine of equivalents for the same reason(s)." *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1365 (Fed. Cir. 2000).

40. The first step in a means-plus-function claim analysis is to define the function(s) being claimed. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001); *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001). The next step is to identify "the corresponding structure, material, or acts described in the specification" for performing the claimed function. *Budde*, 250 F.3d at 1376; *Medtronic*, 248 F.3d at 1311.

Appendix E

1. TriMed Cannot Establish Direct Infringement Because The Accused Plates Do Not Perform The Claimed "Preventing Compression" and "Stabilizing [The] Near End Of The Pin" Functions

41. The functions in the last means-plus-function claim limitation of claim 1 are: (1) allowing the pin to slide axially but preventing compression across the fracture; and (2) stabilizing the near end of the pin against displacement in the plane of the plate.

42. The accused plates do not perform these claimed functions or their equivalents. Accordingly, Stryker does not infringe the asserted claims of the '839 patent.

43. Stryker cannot be adjudged to be an infringer simply because the accused products are capable of being made into an infringing device by a surgeon. *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1310 (Fed. Cir. 2005).

2. The Accused Products Do Not Contain The Structure Disclosed In The '839 Patent Specification Or Its Equivalent For Performing The Claimed "Preventing Compression" and "Stabilizing" Functions

44. The accused plates do not contain the structure disclosed in the '839 patent specification or its equivalent for performing the claimed functions of allowing the pin to slide axially but preventing compression across the

fracture, and stabilizing the near end of the pin against displacement in the plane of the plate.

45. The scope of the means-plus-function claim limitations of claim 1 is confined to those structures which are expressly disclosed in the specification of the '839 patent and corresponding equivalents. *Symbol Techs.*, 935 F.2d at 1575.

46. Because the accused products do not perform the claimed functions or their equivalents, and do not contain the structure disclosed in the '839 patent specification or its equivalent for performing those functions, the accused products do not infringe the claims of the '839 patent literally or under the doctrine of equivalents as a matter of law.

III. CONCLUSION

47. For the above reasons, the accused products do not infringe the asserted claims of the '839 patent either literally or under the doctrine of equivalents. Stryker is entitled to summary judgment of noninfringement as a matter of law.

IT IS SO ORDERED.

Date March 19, 2007
s/ Hon. Manuel L. Real
United States District Judge

Appendix E

Dated: January 16, 2007

Respectfully submitted,

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APPENDIX F — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION DATED AND FILED FEBRUARY 20, 2007

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

No. CV-06-1918 R(SHx)

TRIMED, INCORPORATED,

Plaintiff,

v.

STRYKER CORPORATION,

Defendant.

ORDER DENYING TRIMED, INC.'S *EX PARTE* MOTION TO EXTEND DATES

Judge: Manuel L. Real
Ctrm: 8

The Court has reviewed the papers and arguments related to TriMed, Inc.'s Ex-Parte Motion To Extend The Dates For: (1) Serving TriMed's Damage Expert Report; (2) Filing Its Opposition To Stryker's Motion For Summary Judgment And TriMed's Counter-Motion for Summary judgment, And (3) Authorizing Documents To Be Filed Under Seal.

Appendix F

IT IS HEREBY ORDERED THAT:

1. TriMed, Inc.'s Motion is DENIED.

2. TriMed, Inc. is precluded from submitting any expert report in this case;

3. TriMed, Inc. must file its Opposition to Stryker's Motion for Summary Judgment no later than March 5, 2007; and

4. TriMed, Inc. is precluded from conducting further third-party discovery in this case.

IT IS SO ORDERED

Dated: Feb. 20, 2007

s/ Manuel L. Real
Honorable Manuel L. Real
Judge, United States District Court

APPENDIX G — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING AND PETITION FOR REHEARING EN BANC FILED MARCH 10, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1327

TRIMED, INCORPORATED,

Plaintiff-Appellant,

v.

STRYKER CORPORATION,

Defendant-Appellee.

Appeal from the United States District Court for the Central District of California in case no. 06-CV-1918, Judge Manuel L. Real.

ORDER

A petition for rehearing en banc having been filed by the Appellee, and the matter having first been referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

Appendix G

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on March 17, 2008.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: 03/10/2008

cc: Mark M. Grossman
Gregory J. Vogler

APPENDIX H — 35 U.S.C. § 112, ¶ 6

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.